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Supreme Court of the U[illegible]

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APPEALS IN EQUITY FROM THE U. S. [illegible] SOUTHERN DISTRICT OF NEW YORK.

WILLIAM WRIGHT,

vs.

DAVID G. YOENGLING, Jr.

WILLIAM WRIGHT,

vs.

ANTHONY W. SMITH, JOHNSTON BEGGS and JOHN G. [illegible]

BRIEF FOR THE APPELLANT.

ANDREW J. [illegible]

[illegible] Printing and Job Printing House, New York.

Supreme Court of the United States.

NOS. 5 AND 6, OCTOBER TERM, 1893.

WILLIAM WRIGHT, Appellant, vs. DAVID G. YUENGLING, Jr., Respondent.	Appeals in Equity from the U. S. Circuit Court, for the Southern District of New York.
WILLIAM WRIGHT, Appellant, vs. ANTHONY W. SMITH, JOHNSTON BEGGS and JOHN D. RANKEN, Respondents.	

BRIEF FOR THE APPELLANT.

Statement.

The bills of complaint, filed the 19th day of March, 1885, in these causes, are for injunction and account of profits by reason of the infringement by the respondents of Letters Patent for a new and useful improvement in frames for horizontal engines which were granted to William Wright, the ap-

pellant in this Court, November 18, 1873, No. 144,818.

The defenses set up in the answers are non-infringement, and want of patentable novelty by reason of certain prior patented structures. In the suit against David G. Yuengling, Jr., there is an additional defense that the defendant is a user and not a maker or seller. In the suit against Anthony W. Smith, Johnston Beggs and John D. Ranken there is a defense set up that the alleged infringing structures were not made, used or sold by Johnston Beggs impleaded, but by the Smith, Beggs and Ranken Machine Company.

Proofs on both sides were duly taken and the cause heard before the United States Circuit Court for the Southern District of New York, at the October Term, 1887.

Judge Wheeler, before whom these causes were argued, handed down his opinion February 13, 1888 (Record, p. 76), and on August 1, 1888, a final decree (Record, p. 78) was entered dismissing the bills of complaint, with costs.

From this decree an appeal was duly taken to this Court.

Assignment of Errors.

The Circuit Court, as appears by the opinion in these causes, held that the second claim of the Letters Patent in suit is void, because it does not embrace within said claim subject matter properly patentable under the laws of the United States relating to Letters Patent for mechanical inventions.

Also held that the first and third claims of said Letters Patent were not infringed.

The appellant now assigns the following grounds of reversal:

First.—The Court below failed to properly interpret the specification and claims of the patent in suit, which error led to his improperly applying the law to the case in the subsequent portions of his decision.

SECOND.—The Court further erred in holding that the second claim does not cover any patentable invention, and is hence an invalid claim.

THIRD.—In the suit of Wm. Wright *vs.* Anthony W. Smith, Johnston Beggs and John D. Ranken, the Court further erred in not holding that the defendant Beggs was estopped from setting up that a corporation, and not said Smith, Beggs and Ranken, as partners, was responsible for the acts, matters and things complained of.

I.

Nature of the Wright invention and analysis of the claims.

This invention has reference to an improvement in the art which relates to the construction of frames for *horizontal engines.* It is a *structural mechanical patent*, limited to a single crank engine, and as Mr. Henry B. Renwick says, could have been patented as a design.

It is not the outcome of a love for the beautiful alone, but the result of a careful study of the requirements of the more powerful engines that were being built, and as the specification states, "the attainment of lightness and strength in the construction of frames."

The patent contains three claims, as follows:

1. A horizontal steam engine frame in which a cylinder *b*, for guiding the cross-head, is combined with the cylinder-head *a* and semi-circular connecting piece *d*, substantially in the manner described.

2. The combination, in a horizontal engine frame, of the guiding cylinder *b*, base H, and trough-like connection D.

3. A horizontal engine frame composed of the cylinder-head *a*, guiding cylinder *b*, connecting piece *d*, trough D, base H, and web *t*, all combined substantially in the manner described.

When these claims are read in connection with the specification, it is evident that the subject matter of this invention was properly patentable under § 4886, R. S. U. S. There is a great mind in this invention, in the distribution of material in the making of a frame for horizontal engines. This frame displays great structural strength.

The Court's attention is especially directed to the following statements contained in the latter part of the specification of the patent in suit:

" A strengthening-rib *q*, extends along the upper edge of the side *p* of the trough-like connection D, and is continued along the upper edge of the base H, and also along the upper edge of the side *m* of the trough, and terminates at an extension *f* of the cylinder-head *a*; and in order to add vertical strength to the frame a central web *t* extends from the base H to the cylinder-head *a*, this web merging into the foot *w*, which serves as one of the supports of the frame.

" In horizontal engines there is necessarily an excessive lateral strain on the frame between the cross-head guides and the crank-shaft. This strain is effectually resisted by the comparatively light trough-like portion of the frame between the crank-shaft and guiding cylinder."

The elements of the specification, flanges *q*, *m* and *e*, also web *t* go to the construction of the trough which is LIGHTER and go to the second claim.

These flanges on the trough permit of a much better distribution of metal, less metal and a better and lighter form of engine bed; like the girders and columns of elevated railroad structures, like the vertical columns and beams of builders, this added element prevents buckling and "excessive lateral strain" is prevented with the improved and cheapened structure.

In Exhibit Newspaper Cut D, Smith, Beggs & Co., the defendants admitted the utility of this engine frame in stating that by reason of the peculiar construction as regards the bed-plate (meaning the engine frame) the engine is rendered less liable to get out of line, as well as much more durable, &c., &c.

Mr. Henry B. Renwick, in his deposition at page 48 of the record, folio 94, testifies as follows:

"The engine frame as a whole is, to the eye of an engineer, evidently a frame designed for a horizontal single crank engine and not for an upright or an inclined engine. The fact that it is designed for a single crank engine being clear, not only because the frame is provided with only one pillar block, but because the other side of the frame has no pillar block, nor such a form as would support a second pillar block. The patent distinctly states that that side of the frame which carries the pillar block 'is continued in a plane coinciding with the centre of the cylinder *b*, from the latter to the enlargement *n*, for receiving the bearing of the crank shaft,' while in reference to the other side of the frame it states, that 'the opposite side *p* of the trough extending from the guiding cylinder *b* with a graduaily descending curve to the base H, into which it merges.' Further, the horizontal rib on that side of the frame on which the pillar block is secured, is carried from the pillar block rearwards alongside of the guiding cylinder *b*, until it reaches the steam cylinder-head, while the curved horizontal flange on the other side of the frame is only carried back to the guiding cylinder, thus proving clearly that it was intended to take the greater part of the strain, as must necessarily be the case on that side of the frame which carries the single pillar block for the single crank of Wright's engine. Further, a measurement of the drawing shows that the horizontal flange on the side of the engine which carries the pillar block, is wider, and therefore stronger, than the horizontal curved flange on the other side of the engine, which is the proper construction where only a single crank and pillar block are employed."

"The large foot or base H, moreover, shows clearly that the frame is adapted for a horizontal engine only. The patent is not for a design, although it might have been, for patents have been granted, to my knowledge, for useful, not orna-

mental designs, and the design has to the engineer that beauty which arises from the shape and combination of the parts, being such that they are perfectly fitted for the accomplishment of the desired result. The parts which constitute the engine frame, beginning at the crank shaft end, are first the base H, which is a sort of oval ring, with a wide bearing surface, which is attached to the front end of the trough, and with its centre lying under the crank end of the connecting rod."

"The second part is what the patent calls 'the inclined concavo-convex trough D, deep enough to permit the free movement of the connecting rod.' It is further stated that this trough is provided with the strengthening ribs or flanges I have spoken of, one of which extends in a straight line from the steam cylinder head to the pillar block, and the other of which curves downward as it goes forward and is continued along the upper edge of the base H. The third part of the frame is what the patent calls the guiding cylinder *b*, the axial line of which is the same as that of the steam cylinder; the trough is attached to the front part of this cylinder, and it is stated that this cylinder serves as a cross-head guide 'which can be readily prepared for service by the same bar which is used for boring out the cylinder,' thus doing away with costly fittings, &c. It is not stated in the patent whether this cylinder is to be bored out through its whole circumference in order to act as a guide for the cross-head, or bored out through a part of its circumference, it being evident to an engineer that it must be bored out through sufficient arcs of its circumference to serve as a cross head guide. In a horizontal engine the strains of the cross-head against the guides are in vertical planes, or nearly so, and are none of them in horizontal planes. It is clear, therefore, that if the guiding cylinder be only partially bored out, that the arcs thus bored should be at the top and bottom of the cylinder. It is stated in the specification that lateral openings are to be made in this guiding cylinder, in order that free access may be had to the cross-head."

"FOURTH. — Proceeding rearward, we come to what the patent calls the 'semi-circular connecting piece *d*.' One end of this connecting piece merges into the rear end of the guiding

cylinder *b*, and the other end into the circumference of the steam cylinder head, and it is stated that the open top of said connecting piece permits 'ready access to be had to the stuffing box of the cylinder head.' If this access to the stuffing-box were unnecessary this piece *d* might be a complete cylinder or a conical frustrum. The cylinder head in the description of the patent is also described 'fifth, as forming a part of the frame;' and this cylinder head lies at the rear end of the connecting piece *d*. A long vertical rib marked *t* in the drawing extends from the rear end of the base H under the trough D, the guiding cylinder *b* and the connecting piece *d*, thus strengthening the whole frame to resist strains in vertical plane. The only use that I can see in casting the guiding piece *b* as a cylinder instead of a trough is to provide the necessary upper bearing for the cross-head, and in such location that it can be bored out and trued by the same bar by which the steam cylinder is bored out."

Mr. J. K. Wright, in his deposition at page 13 of the record, folios 26–27, testifies as follows as to 'the exact boundaries of the connecting piece *d*,' which is found in respondent's structure:

"x-Q. 28. Point out and indicate by some permanent mark on the structure, Complainants' Exhibit C, the exact boundaries of the connecting piece *d*, which you say is shown in the Exhibit C referred to?

"A. The connecting piece, as referred to by letter *d* in the Wright frame patent drawing, is substantially covered, in my opinion, by the connecting piece in model C, as shown between arrow heads on said model. The exact point of beginning is supposed to be at the end of the slides.

"x-Q. 29. When you say it is between the arrow heads you mean, do you not, that it includes the entire space between the points of the two arrows which are represented as pointing in a line in opposite directions from each other?

"A. The space included is from the point of the ending of the slides and front face of cylinder, and is supposed to be covered by the arrow heads marked on the model and running in opposite directions."

It is evident that the respondent has in his frame

the appellant's connecting piece. To find such connecting piece we have but to look to where the cylinder guide ends, to wit, at the point where the guides themselves end. There is no need for any cylinder guide beyond that point. Whatever of the structure is found beyond that point, where the guides (the cylinder guides) end and the cylinder head begins, is the connecting piece *d*, and in both appellant's and respondent's structure, the function and location, the beginning and end of that connecting piece are precisely the same.

This testimony gives a very clear view of the invention contained in the three claims, together with an explanation of the results accomplished by, and the value and importance of, the invention.

Mr. Brevoort's testimony on the matter is to be found in his 5th answer, commencing at the bottom of page 35 of the record and extending to the middle of page 39.

So far as his testimony is a departure from that of Mr. Renwick, he is met by Mr. Renwick in latter's answer's to questions 7, 8 and 9, pages 54, 55 and 56 of the record.

Herein it may be said that the question of infringement is very fully discussed by both experts. It is respectfully submitted, that Mr. Renwick gives better reasons for his opinion why the claims are infringed than Mr. Brevoort does in asserting that they are not infringed. Mr. Renwick very fairly, while expressing an opinion that there is an infringement of the 1st and 3d claims, leaves it to the Court to say what construction of the claims shall obtain, in order to hold the defendants' structures as infringements. There is no question, however, in Mr. Renwick's mind, as to the infringement of the second claim. The scope of this claim is so clearly defined in plain English, there is no escaping the conclusion that the defendants' structures, as represented by either complainant's model "B" or defendants' "Correct Yuengling Model," infringe it.

I will now proceed to discuss wherein Mr. Ren-

wick and Mr. Brevoort differ in their testimony. The variances are set out in Mr. Renwick's answers to questions 7 to 10, inclusive. The answer to the tenth question has reference to Mr. Renwick's disagreement with Mr. Breevort relative to the S. Wright, Sandford and Farrar patents set up by the defendants as a part of the "state of the art" in this case.

The first of these differences has reference to Mr. Brevoort's not drawing a distinction between horizontal and vertical engine frames, in order to see an apparent similarity between the patented frame and some of those previously existing in the state of the art. It is conclusive in reply to the matter set forth in Mr. Brevoort's answer to the fifth direct question.

Mr. Renwick's answer is as follows (Record, p. 54, fol. 105):

"I have read the part of the answer referred to in the question, and do not agree with Mr. Brevoort, but, on the contrary, think that there is a great distinction to be drawn between the frames of horizontal, inclined and vertical engines, and even between the frames of different kinds of horizontal engines. This will appear from the patents put in evidence by the defendants herein, they showing that the frames of vertical and horizontal engines are very different, and also that different frames are needed for horizontal engines bolted against a wall, and those resting on a horizontal foundation, and also that frames are needed for back action and trunk engines (both of which are horizontal engines), which differ from the frames of ordinary horizontal engines. Further, there is a difference between the frames of horizontal engines with one crank and those in which two cranks are employed. In all plans for frames, one of the main points to be considered is how to shape a given weight of iron so as to make the strongest structures, having in view the various strains to which the frame is to be subjected when the engine is at work, and I include among those strains to which the frame is subjected the effect of the weight of the various parts and the tendency of the various parts to get out of proper alignment, thus permitting buckling or vibration. And I may here state that I

have seen many frames of engines that buckled at every stroke, including even the frames of small horizontal engines. I myself have planned engine frames and should never think of planning the same frame for use in both horizontal and vertical engines, or even for use with different varieties of horizontal engines. I agree with Mr. Brevoort in his statement that *mere* questions of shape are not to be considered; but when a particular shape is thought out or invented for the purpose of producing a useful effect, then such question of shape is an important one."

The next question raised by Mr. Brevoort is to effect that the claims of the Wright patent were limited by reason of matter contained in the specification restricting such claims to a cylinder bored out throughout its entire internal surface. Here is Mr. Renwick's reply (Record, p. 55, fols. 106-107).

"It is nowhere stated in the Wright specification that the guiding cylinder is to be bored out over its whole internal surface, nor are the claims limited to a cylinder thus wholly bored out so as to be smooth all over on its internal surface, the question whether the cylinder is to be bored out on its whole internal surface or only on a certain portion of that surface is an immaterial one, provided that when it is only partially bored out it is bored out to a sufficient extent to prevent the cross-head cutting, and that the boring out is done in such lines of the cylinder as will properly support the cross-head against the strains to which it is subjected; and this is the way in which the guiding cylinders of the Yuengling models are bored out, namely, on the bottom and top of the guiding cylinder, and to a sufficient extent to prevent the cross-head from heating or cutting."

II.

Distinction to be drawn, and essentials of design and mechanical patent.

From the decisions of this Court, it appears to have been the rule to sustain a patent for a mechanical invention where there has been found therein the elements of novelty and utility besides originality and the exercise of the inventive faculty. If these essentials be found in a patent to however small a degree, the patent should be sustained.

These same essentials, except utility, are necessary to a patent for a design for which is substituted a something that gives a pleasing appearance or effect to the eye. This something may be beauty, or it may be amusing, to the extent that it is pleasing, and even to an extent that it is an incentive to the usefulness of the article itself. Utility that is found in a design patent is such that it ought to be termed passive; whereas, utility such as is necessary to a patent for a mechanical invention is such that, *per se*, it accomplishes the desired result, and such utility is present in the Wright patent.

The Acts of Congress, which authorize the grant of patents for designs, were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the Acts.

Gorham Mfg. Co. *vs.* White, 6 Fish. Pat. Cases, 100.

This patent should not be construed to be for a design.

In the words of Judge Lowell:

"A patent for a new article of manufacture is trespassed upon by an article having the same sort of utility arrived at by the same or similar means, whereas the test in a patent for a design is similarity

to the eye. (Gorham Company *vs.* White, 14 Wall., 511.) It would, therefore, be unfair to the public, not only as respects the term of the patent, but the nature of the grant, to construe one sort of patent as being of the other sort; and I think it clear that the statute intends the particular kind of grant to be set out in the deed."

Cone *v.* Morgan Envelope Co., 4 Ban. & Ard., 110.

III.

Infringement.

The decision below concedes infringement of the second claim, but contends that it is invalid because it is for an aggregation of elements that do not perform, by reason of their combination, any new and useful result. In other words, that such elements only perform in the Wright engine bed or frame, in which they are combined, independently or singly the function or result they peform in other structures shown in the prior state of the art, and that no combined new result is attained by their combination.

This second claim is not an aggregation of separate machines, each working out its own end to a final result.

Neither the base nor even the cylinder and trough are found anywhere else, nor such construction of trough D.

Furthermore, the result is due to the action of both trough and cylinder, viz.: the preventing of strain in both lateral and vertical directions.

The patent is *prima facie* valid. It is a muniment of title, and the evidence to overcome it must clearly preponderate. If a reasonable doubt exists it must be resolved in favor of the validity of the patent.

The second claim is novel because it is found nowhere in the art. The defendants have infringed it, as also the first and third claims, if this Court holds that the first and third claims are not strictly and definitely limited to a steam cylinder-head cast in one piece with the frame.

The decision below further concedes the connecting piece *d* to be new, hence it follows that the combinations as contained in claims first and third are new and are not met by the patents relied on as anticipations.

Mr. Brevoort in his fifth answer states (p. 39, fol. 78) that the first and third claims are not infringed for three reasons, namely,—because defendants' structures have not

"1. Any cylinder head or equivalent therefor."

"2. Because they have not got a semi-circular connecting piece, and as I understand the patent, it is limited to a connecting piece made in the form of a semi-circle."

"3. Because they have not got a guiding cylinder as such, but merely an upper and lower guide, one at the top and the other at the bottom, cast into that which, in the Yuengling structures, has been wrongfully called a guiding cylinder."

Mr. Renwick, in his answer to Q. 9, p. 55, fol. 107–109, replies as follows:

"I understand from Mr. Brevoort's testimony that in the Yuengling contrivance the steam cylinder head, instead of being separate from the cylinder, as usual, is cast in one piece with the cylinder, so that there is only one joint necessary to attach the steam cylinder to the frame instead of two, as would be the case if the cylinder and cylinder head were cast separately. The cylinder is, therefore, attached to the frame in Yuengling in an equivalent manner to what it is in the Wright contrivance; and if the Court shall not hold the words of the Wright specification, viz., 'the extreme rear end of the frame, and forming part of the same, is the head *a* of the steam cylinder A,' as controlling to the extent that the cylinder head must be cast in

one piece with the rest of the frame, then the defendant does not escape infringement by casting the cylinder head in one piece with the steam cylinder, and securing both by one set of bolts to the frame."

"The cylinder head is really no part of the frame, but, on the contrary, a part of the cylinder."

"I understand from Mr. Brevoort's statement, that he thinks that the Wright patent in suit is limited to a semi-circular connecting piece, 'one made in the form of a semi-circle.' I do not understand this statement to be correct; first, because the Wright drawing shows clearly that the connecting piece is not of that form throughout its length, but, on the contrary, is in parts more than a semi-circle, as will clearly appear both by reference to the drawing and the Patent Office model. Second, because this connecting piece is the same, whether it has a greater or less aperture in it, provided the aperture is sufficiently large to permit 'ready access to be had to the stuffing-box;' and in the Yuengling device, as illustrated by the models in evidence, there is sufficient opening in the connecting piece to permit of ready access to the stuffing-box."

"I understand further, from Mr. Brevoort's testimony, that the guiding cylinder of the Yuengling contrivance is a cylinder in which those parts of the circumference which guide the cross-head are trued up by a bar, which is used for boring a complete cylinder; and he attempts to draw a distinction between the guiding cylinder of the defendants and the Wright cylinder, because the latter is only bored out through certain arcs, while he supposes the former to be described as being bored out over its whole internal surface. As will appear from what I have before stated, I do not think this difference is a material one, and do not think that Wright's description limits the invention to a guiding cylinder, which must, of necessity, be bored out over its whole inner surface. The cylinder, whether fully or partly bored out, not only forms, in the words of the patent, the main body of this portion, but serves at the same time as a cross-head guide, which can be readily prepared for service by the same bar which is used for boring out the cylinder."

"In my opinion, defendants would infringe all the claims if the Court holds that the first and third claims are not strictly and definitely limited to a

steam cylinder head cast in one piece with the frame. The second claim, it is evident, does not include the cylinder head as an element thereof."

The language in the first part of the specification, namely, "and forming part of the same," referring to the cylinder head *a* and the steam cylinder A, is not used in the sense that the cylinder head *a* must necessarily be cast as part of the frame any more than should a chair-back be carved from one piece of wood because we speak of such back forming a part of the chair.

The respondent infringed the first claim when he cast the cylinder head in one piece with the steam cylinder and secured both by one set of bolts to the frame. This was new to the art, and the appellant was the first one to accomplish this.

Mr. James K. Wright also testifies to the infringement (pp. 9–17 of the Record).

IV.

The state of the art does not impair any one of the claims of the patent in suit.

Let us review the patents introduced in evidence upon which testimony was had.

The Samuel Wright Patent of 1837.

Mr. Brevoort testifies at page 39, folio 79, relative to this patent as follows:

"I will speak first of the Samuel Wright patent of 1837. This patent shows a locomotive, the cross-head of which is guided within a guiding cylinder, which is a true and complete cylinder, as in the case of the Wright patent in controversy and the certified duplicate of the model. In the old locomotive this cylinder is bored true, and the cylinder, besides

guiding the cross-head, also serves the purpose of a pump. All that this patent shows in this connection is that a cylindrical guide was old, and by a cylindrical guide I mean a guide which is formed from a complete cylinder, like the guides of the Wright patent in controversy, and not a so-called cylindrical guide, such as is found in the Yuengling structures."

Mr. Renwick, in reply in answer to the 5th question (p. 50, folio 98), states as follows:

"This patent describes an old-fashioned locomotive engine, in which the supply or feed-pump cylinder appears from the patent, but is not specifically described, to be bolted fast to the frame of the cylinder with an interval between it and the steam cylinder. There is no other way of supporting the feed-pump than this, so far as I can discover from the patent, and it therefore makes no part of the engine frame, but is merely bolted to the engine frame as the usual cross head guides are. The patent does state in substance that the axial line of this feed-pump is to be the same as the axial line of the steam cylinder, and that the pump piston would therefore serve as a cross-head guide for the steam piston rod, but they would not be bored out after the two were in place, as no mechanic would think of boring them out, after they had both been bolted on to the engine frame."

"Moreover, there are not and cannot be any holes or apertures in this pump cylinder for getting at the cross head; and further, this pump cylinder must have a head and a stuffing-box to it on the end nearest the steam cylinder, in order to make it a pump."

"I find in this patent no description of any element of the invention of the Wright patent in suit, and even if I be in error on this point as to the pump cylinder of Wright 540, being the guiding cylinder of the Wright patent in suit, it is perfectly evident that this Wright patent 540 has not the semi-circular connecting piece, D, of the first claim of Wright in suit, nor the base, H, and trough-like connection of the second claim, nor these same parts in the third claim, or the web, *t*, which is also a part of the third claim."

It is conclusive that this S. Wright patent does not touch any of the claims in controversy.

THE GELSTON SANFORD PATENT OF 1859.

Mr. Brevoort testifies at page 40, folio 80, as follows:

"The patent of Gelston Sanford of 1859 shows a vertical steam engine in which there is a cylindrical guide, cast solid with the steam cylinder, and the patent says, as follows:

> 'I bore out the elongated part on a line corresponding to the sides of the cylinder, which gives a true line for the cross-head, E, to work in.' * * *

"I will quote from another part of the patent:

> 'I make all the connections in the ordinary way. The great advantages of this mode of construction are in the use of a cylindrical form of the cross-head "E," working in a cylinder, making the whole more simple and cheaper, and less liable to get out of order.' * * *

"This patent, like the last one, shows that it was old to attain true alignment of the steam cylinder and cross-head guide by boring with the same bar. Of course, in this patent there is a connecting piece between that portion of the frame in which the cross-head works and the cylinder, and if the Wright patent is broadly for any connecting part or portion, however shaped, then there is such a connecting portion in the Sandford patent. I might remark before I leave this patent, that the draughtsman has made an error in the location of the steam piston or of the crank. The piston ought to be at the top of the stroke if the crank is not altered, or if the piston is not altered, the crank should be at the bottom of the stroke."

Mr. Renwick refers to the Sanford patent at p. 50, folio 99, as follows:

"I could not understand this patent from the Patent Office copy and lithograph drawing; neither can I understand it from the large tracing drawing which is an exhibit in the case. I cannot find out how the crank shaft is to be got into place, nor how the cylinder head which contains the stuffing-box is to be secured in position. The frame is evidently the frame of a vertical or upright engine, not of a horizontal one, the drawings showing this. And it is manifest that the engine has not either the trough like connection or the web *t*, or the base H of the Wright patent in suit, and therefore does not exhibit the invention referred to in the second and third claims thereof."

"Further, this Sanford patent does not show any semi-circular connecting piece *d* or connecting piece with apertures in it, which will give access to the stuffing-box; and I can find no way of getting at the stuffing-box in this Sanford patent, in case it should leak or get out of order, except by taking out both cylinder heads and the steam piston; and I suppose in making this statement that the cylinder head H can be taken out, but see no way shown by the drawing in which this can be done. The Sanford engine as described and represented is an impracticable one."

The Sanford engine is not only shown to be an inoperative structure, but it is shown not to contain features of any one of the three claims in controversy.

The William Wright Patent of 1865.

Mr. Brevoort, at p. 40, folio 81, testifies relative to this patent as follows:

"This patent shows a horizontal engine bolted to a boiler. The frame is constructed as follows, and I quote from the specification of the patent:

> 'That the head of the cylinder '*a*' is cast in one piece with the bed-plate or frame 'F,' which is a shell of a semi-cylindrical form, so as to partially enclose the moving parts of the engine.'

"Thus this frame has the cylinder head '*a*' of the Wright patent in controversy. It has a semi-circular connecting piece which is exactly like the semi-circular connecting piece '*d*' of the Wright patent in controversy, and this connecting piece gives access to the stuffing-box of the steam cylinder, and at one end merges into the cylinder head and at the other end into that part or portion of the frame which constitutes the guides. It is true that in the Wright patent of 1865 the guides are not trued up with a boring bar, but are trued up in some other way. Now this patent shows, when taken in connection with the two previous patents, that it was well known to any mechanic how the guiding surfaces could be trued up either by a boring bar, by a planer, or any other well known and desired fashion. Consequently in the Wright patent of 1865, though guides are shown which are not trued up by a boring bar, any mechanic knew, or rather would have known in the year 1865, that such guides could have been trued up by a boring bar, if such had been desired in constructing the engine, as well as by a planer, or by hand work, and consequently, althought the Wright patent of 1865 shows guides which are differently trued up from the Wright patent in controversy, the two kinds of guides were well-known substitutes for each other, and an engine containing one form is not substantially different from an engine containing the other form, beyond the mere fact of the employment of different old methods to accomplish the same result. As a matter of fact, to-day, I do not think it would be wrong to state that over 90 per cent. of the engines now in motion have guides trued up as would have been the guides of the Wright 1865 patent, and not guides trued up by a boring bar, as in the Wright patent in suit, or the old patents of 1837 and 1859, which I have referred to. Consequently, the semi-circular connecting piece of the Wright 1865 patent, although it does not merge into a cylindrical guide, merges into its then well-known mechanical substitute. Beyond the guiding portion of the frame of the Wright 1865 patent, the said frame is formed into a cylindrical trough-like shape and terminates in an enlargement for the shaft bearing. The old 1865 Wright engine, therefore, has the cylinder-head, the semi-circular connecting piece, guides

which were well-known mechanical substitutes of the guides of the Wright patent in suit, and a trough-like termination of the frame extending to the pillow block."

Mr. Renwick, at p. 51, folio 99, testifies relative to this patent as follows:

"This patent represents a horizontal engine, but not one like that of Wright in suit; it is not to stand on a horizontal base. On the contrary, it consists of a frame which is to be bolted to the vertical side of a boiler, and consequently must differ in many respects from the Wright engine frame in suit. This frame may be considered, as a whole, as the half of a pipe or tube, the plane which cuts the tube in two being a vertical one. This semi-tube is not bored out to form guides for the cross-head; but the guides are evidently separate pieces bolted or otherwise secured to the edges of the semi-tube. They are clearly shown in Figs. 1 and 3 as being separate from the tube, and their shape and that of the cross head demonstrates clearly that they are not bored out, but planed. There is no trough-like connection in this patent, 49,334; no base, no web *t*, no guiding cylinder bored out to receive the cross-head and serve as a guide, and the only elements of the Wright patent in suit found in this claim of Patent 49,334 are the semi-circular connecting piece *d* and the steam cylinder head *a*. I have read Mr. Brevoort's testimony in relation to this patent and desire to say further that the trough like piece which carries the guide in this Wright patent 49,334 is only a semi cylinder or a little more than a semi-cylinder, and could not be bored out by a boring bar so as to serve as a guide for a cross-head. The trough-like piece must be of considerably greater arc than 180° in order to be bored by a boring bar and give sufficient support to the cross-heads."

The Root Patent of 1866.

Mr. Brevoort testifies at page 41, folio 82, relative to this patent, and Mr. Renwick at page 51, folio 100; but as Mr. Brevoort admits it only shows that cylindrical guides were very old and well-known devices, it is unnecessary to review the evidence.

The Wilson Patent of 1871.

Mr. Brevoort at page 41, folio 82, testifies relative to this patent, and Mr. Renwick at page 51, folio 101. Mr. Brevoort concedes this patent only shows a *double* trough-like connection, and a semi-circular connecting piece, without any other element of the claims in controversy. Mr. Renwick testifies, it has nothing in common with the Wright patent excepting the semi-circular connecting piece.

It is evident that the patent does not meet any one of the three claims in suit.

The Maxwell & Cope Patent of 1872.

Mr. Brevoort testifies at page 41, folio 83, relative to this patent as follows:

"This patent shows a back-acting engine, that is, two connecting rods extend backward and past the cylinder and make connection with the cranks at the rear of the cylinder.

"The patent says as follows in regard to the cross-head guides:

> 'The cross-head is turned off to conform to the guideways which are fitted for the cross-head by boring at one setting to bore the steam cylinder.'

"Thus it is clear that the guides which are here shown as upper and lower slides or fitting strips are bored out truly with the steam cylinder. It does not appear how the cylinder head is inserted; whether it is cast as a part of the frame, or as part of the cylinder, but whichever way it is cast there are connecting pieces connecting the guides with the cylinder, which are the equivalents of the part '*d*' of the Wright patent, if that part is understood as covering any and all forms of connecting portions between the guiding portion of the frame within which the cross-head works and the cylinder or the cylinder head. The frame of the engine is carried back of the cylinder and there terminates in the bearings for the shaft, and in a base or pedestal. The frame toward the end assumes a trough like form. This Maxwell & Cope engine shows a cylinder, the equivalent of the connecting piece '*d*,' if

such piece can be said to include the part in the Yuengling structures that is said to be its equivalent. The Maxwell & Cope engine also shows guides for the cross-head trued out at one setting with the cylinder by a boring bar, the said guides being clearly the equivalent of the guiding cylinder of the Wright patent, if such part of the Wright patent can be said to cover the guiding arrangements of the Yuengling engines. The Maxwell & Cope engine shows a trough-like connection and a rib running along the entire frame."

Mr. Renwick testifies at page 52, folio 101, relative to this patent, as follows:

"The patent to Maxwell & Cope, No. 123,635, represents and describes what is commonly known as a back-action engine, that is, one in which the cross-head is in one end of the steam cylinder and the cranks are on the other end of the same cylinder. This kind of engine necessarily involves two cranks (not one only as in Wright), and two connecting rods, whereas the Wright frame is designed for an engine with one crank and one connecting rod only. This engine has a guiding cylinder somewhat like the cylinder *b* of the Wright patent and perhaps, although I am not perfectly certain on this point, an equivalent for the semi-circular connecting piece *d* of the Wright patent in suit, and the guiding cylinder can be bored out by the same boring bar which bores out the steam cylinder, but the guiding cylinder is stopped up at one end, whereas Wright's is open, so that in Maxwell, as clearly described in the patent, the cross-head must be made in two sections or pieces. Moreover, such stopping up of the guiding cylinder at the end furthest from the steam cylinder would be fatal in Wright's device, because, in such a contrivance the connecting rod of Wright could not play in the required manner."

"Moreover, in the Maxwell patent, there is no trough like that of Wright. There are two species of ears projecting from the end of the cylinder furthest from the stuffing box to sustain the two pillar blocks, and these ears are not in the position of Wright's trough, but on the opposite end of the steam cylinder, and therefore combined in a different way with the guiding cylinder and the con-

necting piece *d* of Wright, because in Wright the connecting piece, the guiding cylinder and the trough are all on the same end of the steam cylinder, while in Maxwell & Cope the connecting piece and their guiding cylinder are at one end of their steam cylinder, and the ears which support the two pillar blocks are at the other end of the steam cylinder. It seems to me that it is very clear that this patent to Maxwell & Cope does not exhibit any of combinations referred to in the claims of the Wright patent in suit."

It is evident from the testimony of both the experts on this point that the Maxwell & Cope structure has not got appellant's guiding cylinder of the patent in suit, as it is stopped up at one end, and the cross-head is made in two sections, having to be lifted out in parts at the side instead of being pulled out entire with the connecting rod at its end through the trough as in the Wright frame. Also as Mr. Renwick testifies, there *is* no trough in it like that of Wright. In fact it cannot be said to have any trough at all. It has only a supporting frame to the piston cylinder and the extension in which the divided cross-head slides.

THE FARRAR PATENT OF 1872.

Mr. Brevoort testifies at page 42, folio 84, relative to this patent, as follows:

"This patent shows a frame for a horizontal steam engine, having at one end the cylinder head cast with the frame, a connecting piece, connecting this cylinder head with the guiding portion, a trough-like frame running from the guiding portion to a base or pedestal, and having the appropriate bearings for the shaft; and also the frame has a rib which is in substance the web '*t*' of the Wright patent, running from one end of the frame to the other. This patent of Farrar has all of the features of the three claims of the Wright patent in suit, with the exception of one difference, if it may be so called, and that is this: Instead of having guides trued up by a boring bar in the old and well-known way, it has flat guides, which are known as a me-

chanical substitute (and have been known ever since the first days of steam engineering), for a cylindrical guide, or a guide trued up with a boring bar. I have known of the existence of guides like Farrar's for over twenty years. In my judgment there is no invention in substituting for the flat guides of Farrar the guides of S. Wright and of Sanford, in which event the Wright structure and the Farrar structure would be substantially identical. It is true there is a difference in shape in the frame, but this, as I have before said, is not a suit on a design patent for shape or configuration, but is a suit for an engine frame cast in one piece, and having certain portions or parts so called. It is true that Farrar's frame is adapted for a double crank, while Wright's frame is adapted for a single crank, but I do not find that this is referred to as an especial feature of the invention, and indeed I suppose that if the frame of the Wright engine was provided with a bearing on the other side of the trough, it would be no less the Wright frame, for it is not a question involving novelty to cut away one side of the Farrar frame if a single crank is to be used."

Mr. Renwick testifies at page 52, folio 102, relative to this patent, as follows:

"The patent to Farrar, No. 124,801, describes a frame for a horizontal engine. In this engine the frame is a trough-like but not Wright's trough-like connection, extending all the way from the steam cylinder to the pillar block. This trough-like connection is also provided with rib or web *t* of Wright, which extends underneath the trough like connection from the steam cylinder to the end thereof. And this trough-like connection of Farrar is supported at the end furthest from the cylinder by a base or foot piece E of the Farrar drawing. But the trough-like connection of Farrar is different entirely from that of Wright in suit. Farrar's is a trough designed for supporting two pillar blocks and two cranks. Both upper edges of the trough are horizontal, as they must be for an engine like Farrar's, and neither side of the trough extends as specifically described in Wright's patent, 'from the guiding cylinder with a gradually descending curve to the base into the upper portion of which it merges.' It is clear, therefore, that Farrar has not the trough

of the Wright patent in suit. Further, it is clear that the Farrar patent has the ordinary planed guides for the cross-head, bolted or in some other way attached to the trough, and also that the trough is such a small portion of the circumference of a whole circle that it could not be bored out to form guides for the cross-head, this latter point appearing conclusively from inspection of Fig. 5. I have said before that the cross-head must be supported by a cylindrical guide in a horizontal engine at the top and bottom. The inspection of one of the Wright prior patents and that of Maxwell & Cope will show that they understood this; but in the patent to Farrar the whole of that portion of the trough to which the guides are bolted lies below a horizontal plane passing through the axis of the steam cylinder. Consequently if the trough were made a little larger and bored out (neither of which constructions are described in Farrar's patent) it would still not be Wright's guiding cylinder unless it were continued upwards, so that portions of it would lie directly above the piston rod."

"I do not find in this patent any of the elements referred to in the claims of the Wright patent in suit, except, perhaps, the connecting piece *d*, and certainly the cylinder head cast in one piece with the frame. Neither of these are claimed separately or together in the Wright patent, but only in combination with other elements. This patent to Farrar exhibits a much closer resemblance to the Wright invention than any other of the prior patents, but nevertheless does not show the Wright invention or the combination of elements referred to in the claims thereof."

This Farrar trough as seen in Fig. 2 is designed for supporting two pillar blocks and two cranks. It is not, as Mr. Renwick testifies, in substance a trough extending from a guiding cylinder with a gradually descending curve to a base into the upper portion of which base it merges, the base being a support for a single crank. It therefore lacks the trough of the Wright engine in suit. It also lacks the guiding cylinder for the cross-head. Mr. Renwick testifies that the trough is such a small portion of the circumference of a whole circle that it could not be bored out to form guides for the cross-head. It

could not therefore be said that taking the guiding cylinder of the S. Wright engine as a well-known substitute, with a Farrar form of trough, that there would be created the engine frame in suit, as Mr. Brevoort substantially testifies. This is explained by Mr. Renwick further by stating that the whole portion of the trough to which the guides are bolted lies below a horizontal plane passing through the axis of the steam cylinder, it being shown from the Wright and Maxwell & Cope prior patents that they understood the importance of having the relation of the parts, while in this Farrar structure the Maxwell & Cope and S. Wright guiding cylinders could not be substituted, as the arrangement of the parts is not adapted thereto. It would necessitate, as shown by the termination of Mr. Renwick's answer on this patent, many changes before the substitution of one form of guides could be made for the other; hence Mr. Brevoort's reasoning does not bring this patent within the claims in controversy.

THE CUTLER PATENT OF 1872.

Mr. Brevoort testifies at page 43 (fol. 85) relative to this patent, and Mr. Renwick at page 53 (fol. 104). As it is only introduced as a part of of the "state of the art" relative to the old Wright V shaped guides, it is unnecessary to discuss the testimony relative to it.

THE BABCOCK PATENT OF 1872.

Mr. Brevoort at page 43 (fol. 85) does not say that this patent touches any of the claims in suit.

Mr. Renwick at page 53 (fol. 104) says that it evidently has none of the elements of the Wright frame except the connecting piece *d*.

Several other patents were introduced in the case. The defendants' expert did not testify relative to them. Mr. Renwick at page 53 (fol. 104) recites them, and says that they do not exhibit or describe

the inventions referred to in the claims of the patent in suit.

It appears, therefore, that none of the patents referred to by defendants' expert anticipate any of the claims in controversy; also that said patents, together with those he did not refer to, exhibit some one of the features of these various claims with the exception of the trough like connection claimed in each of the claims in controversy except the first. This trough-like connection is entirely new in itself. It is adapted, as Mr. Renwick testifies, as a connection *between a guiding cylinder and a base containing the pillar block of a single crank engine.* It has its metal distributed in a way that contributes *a very efficient engine frame* for a single crank engine, such as had never before been exhibited in the "state of the art," and forming *an entire connection between the pillar block and the cylinder, with a cylindrical cross head guide which can be bored out with the same tool as is used in boring out the cylinder.* This tool need not be used at the same time to bore out both cross-head guide and piston cylinder, but the same tool is used to do both duties. This is substantially conceded by defendants' expert, and is fully explained by complainant's expert, as previously quoted in this brief.

V.

This is not a patent for an aggregation of elements such as would avoid the patent in a legal sense; further, the patent is not invalid if the elements of the respective claims are not found in any one old structure.

The testimony of Mr. Brevoort given in answer to question 7, pp. 44–45, is not that the claims are anticipated by either the S. Wright, the Sanford,

or the Farrar patent, but that he finds in first, second and third claims a portion of the elements of the S. Wright and Sanford patents, and the remainder in the patent to Farrar. It is settled law that the claim of a patent cannot be anticipated by finding some one or more of the elements in one and the remainder in another old structure. The subject matter claimed must be found in one and the same old structure.

Latta *v.* Shawk, 1 Bond, 259.
Imhauser *v.* Buerk, 101 U. S., 647.
Bates *v.* Coe, 98 Id., 48.

In answer to question 8 Mr. Brevoort endeavors to show that the features claimed in this engine bed of complainant is a mere aggregation of elements, not co-operating to produce one and the same result. The claims of the patent in suit are not such as were condemned in the suit of Hailes *vs.* Van Wormer, 20 Wall., 353, which was the first case in which the doctrine of "aggregation" was laid down by the U. S. Supreme Court. In that suit the infringement of a stove was in question. Certain parts were said to be embodied in one claim which had neither any connection nor any bearing upon each other, such as mica lights and reverberatory flues, &c. This is different from combining elements in an engine bed where the accumulation of elements tends to make a stronger structure which will better support the heavy engine or weight under which it is placed. This is all important, particularly in view of vibration in the movement of the piston rod, crank, fly-wheel and crank shafts. In the course of the use of the engine many engine beds become unsteady. In this use the parts of the engine itself wear unequally, which necessitates constant repairs. The importance, therefore, of having one homogeneous structure, made up of many parts properly, is all important. They all co-operate to one end, unlike the case of the elements in the stove above referred to.

VI.

As to the defense that the respondent Yuengling, Jr., is a user only and therefore not liable.

It is only necessary in answer to this defense to make reference to the statute which gives the right of suit against either "maker, user, or seller." The grant of a patent is a franchise, and the patentee is entitled by statute to the remedy of an injunction if the claim is violated and the infringer does not take a license.

VII.

Smith, Beggs and Ranken were estopped from setting up that a corporation and not they themselves were liable. They should be ordered to account as partners from the books of the corporation.

"Beggs, impleaded," may not be a partner of the other defendants; but he has so represented himself to the community, including this appellant. It also appears that he is the only one of the defendants (or their corporation) that sold the machines, and he was therefore subject to the injunctive power of the Court, at least for those acts. If the Court erred in not granting such injunction the appellant should be entitled to an accounting during the time such injunction might have been in force.

The defendant, Johnston Beggs, testifies in answer to the 53d question, page 32, folio 63, that he is the president of the Smith, Beggs & Ranken Machine Co., and further adds that *he has specific charge of the selling of the machines, and also of the erec-*

tion of them in the respective places where they go. Of the other members of this company, Smith has charge of the work in the shops, and Ranken of the financial affairs. It is, therefore, clear that the defendant Beggs, impleaded, *is the active man*, whether of a copartnership or a corporation is immaterial, *in the selling and putting up of these* infringing engine beds, which, of course, includes that put up in the defendant Yuengling Jr.'s premises.

The Courts have uniformly held that even superintendents and employees who are engaged in the infringement by reason of the selling of their employer's infringing structures can be enjoined.

Maltby *v.* Bobo, 14 Blatch., 53.
Morse *v.* Davis, 5 *Id.*, 40.
Am. Cotton Tie Sup. Co. *v.* McCready, 17 *Id.*, 291.
Potter *v.* Crowell, 3 Fish P. Cas., 112.

Irrespective of this, it appears that the defendant Beggs, impleaded, has represented to the public that he was a partner with Smith and Ranken. He admits that he informed complainant and his counsel before these suits were commenced that he would see his partners, Smith and Ranken, relative to a proposed settlement (p. 30, fol. 59). It further appears that in their newspaper advertisements these three men were called *by name of Smith, Beggs & Co., and that such catalogues were continued to be circulated down to the date the suit was instituted* (p. 30, fol. 60). Further, that on their engine frames the firm name was placed, namely, Smith, Beggs & Co., St. Louis (p. 32, fol. 62). Whether these defendants were a copartnership or a corporation is not very material, if they held themselves out as a copartnership to the public, *and if the defendant Beggs, impleaded, did the whole of the selling and putting up of the infringing structures.* So far as this case is concerned we were undoubtedly entitled to a decree against said Beggs, if not to an account-

ing, and since by reason of the lower Court's error we have been deprived of the right to an injunction, it seems just that we should be entitled to an accounting against the three defendants as partners.

The respondents in the one suit have wrongfully held themselves out to the public as partners, and so misrepresented themselves to the complainant's counsel. Such misrepresentation was made with the knowledge that they were not partners. The party to whom the representation was made, namely, the complainant's counsel, was ignorant of the truth of the matter, *i. e.*, that they were not partners but were doing business in a corporate capacity. From the attending facts, an intention should be imputed to the respondents of having made the misrepresentation with the view that it be acted upon. Mr. Johnston Beggs, whose testimony is above referred to, knew that this suit was to be brought, and in view of such knowledge he should have spoken the truth to one who would otherwise have sought elsewhere for a knowledge of how they did business. Smith, Beggs and Ranken were also holding themselves out as partners to the world, advertising as Smith, Beggs & Company, and so signed their checks. Complainant's counsel was induced to bring suit against Smith, Beggs & Ranken as partners because of these representations. The elements of an *equitable* estoppel seem to be present. There is no excuse for an officer of a corporation holding himself and the other officers out to be partners, and further, there can be imputed no good intention to such officer for so doing. In the case at bar, in the event of this Court's holding that the Letters Patent sued on are valid and have been infringed, the defendants Smith, Beggs & Ranken should be ordered to account as partners from the books of the corporation.

The assertion of an untruth may operate to estop a party from subsequently setting up the truth.

Bisham's Prin. of E., 4th Ed., Sec. 283.

Admissions, whether of law or fact, upon which another has acted, who would be injured by permitting the truth of them to be disproved, operate as an equitable estoppel.

42 Barb., 18.
47 *Id.*, 206

One who by his declarations or conduct has induced another to act in a particular manner, which he would not otherwise have done, will not be afterwards permitted to set up a claim inconsistent with such declaration or conduct to the injury of the other party or those claiming under him.

18 N. Y., 457.
41 Barb., 359.
4 Sand., 361.

VIII.

The infringement of the patent in suit commenced after the appellant had put his patented structures on the market, and from this source alone and not from the "State of the Art" or from their own originality in pattern making did the respondents obtain knowledge of the Wright invention.

It appears from the proofs that the patent in suit was granted in the year 1873, and it is quite evident that the respondent Beggs and others first saw the Wright engine frame before making their patterns to substantially correspond.

The close similarity of the frames is sufficient to substantiate this statement. It would appear that the respondents Smith, Beggs and Ranken early contemplated infringing the Wright structure, as they advertised in Exhibit D, a centennial engine, giving a cut of it, stating that "the engine was named the centennial, in honor of its birth."

There is no question whatever but that these infringing structures were copied from one of the Wright engine frames, which were put into use at an early date in the West.

IX.

It is respectfully submitted in conclusion, that the first, second and third claims of the William Wright patent, No. 144,818, ought to be sustained as for a mechanical invention, and that the appellant is entitled to a decree to be entered to such effect, and for an accounting and costs in the suit against Daniel Yuengling, Jr., and to a like decree in the suit against Anthony W. Smith, Johnston Beggs and John D. Ranken, the accounting to be ordered against said Smith, Beggs and Ranken as partners, and the books of the corporation to be used for such purpose.

ANDREW M. TODD,
Counsel for Appellant.

Supreme Court of the United States,

OCTOBER TERM, 1891.

WILLIAM WRIGHT, Appellant, *vs.* DAVID G. YUENGLING, Jr.	No. 92.
WILLIAM WRIGHT, Appellant, *vs.* JOHNSTON BEGGS, Impleaded, etc.	No. 93.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

BRIEF FOR APPELLEE.

Statement.

These are appeals from final decrees in equity, made on the first day of August, 1888, in favor of the defendants, dismissing the bill of the complainant in each case with costs.

These two suits are brought for an alleged infringement of Letters Patent of the United States, granted to William Wright for improvement in frames for horizontal engines, dated November 18, 1873; application filed July 26, 1873; No. 144,818 (p. 58). No date of invention prior to the date of application is proved.

The bill in the first above-entitled cause was filed March 19, 1885. The answer was filed December 7, 1885, and the replication January 4, 1886.

The defendant Yuengling is a brewer, and the thing complained of as an infringement in his suit consists of the frame of a steam engine, which actuates the refrigerating machine used for the purpose of cooling the storage rooms and rooms in which the process of fermentation is carried on in the manufacture of lager beer (pp. 25, 26).

The machinery in question was built at St. Louis, Mo., by the Smith, Beggs & Ranken Machine Company, a corporation created by and under the laws of the State of Missouri (pp. 27, 28, 32).

Soon after this suit was commenced, Johnston Beggs, the president of said corporation, being found within the Southern District of New York, the plaintiff filed a bill against "Anthony W. Smith, Johnston Beggs and John D. Ranken, doing business under the firm name and style of The Smith, Beggs & Ranken Machine Company, at the city of St. Louis, in the State of Missouri" (p. 8). Johnston Beggs was alone served with process and he alone appeared and answered (p. 8).

The bill in the second suit was filed July 31, 1885. The answer was filed December 7, 1885, and replication filed January 4, 1886.

The more important defenses set up in the Yuengling suit are as follows:

That the patent is not infringed (p. 4).

That said Wright was not the original and first inventor of any material and substantial part of the thing patented, giving the names of a number of prior patentees and the dates of their patents (p. 5).

That in view of the state of the art, the alleged improvement, described and claimed in said Letters Patent, was not in its nature the subject of Letters Patent of the United States (p. 6).

The defendant demurs to the parts of the bill claiming damages. The defendant also alleges facts showing that this is not a case for an equitable remedy, and that therefore this Court, sitting as a Court of Equity, has no jurisdiction to entertain this suit (pp. 6, 7).

The answer of the defendant, Johnston Beggs, sets up, substantially, the same defenses, except the paragraph numbered X, and also sets up "that the machines complained of as an infringement of the Letters Patent upon which this suit was brought, were not made, used or sold by this defendant, but were made and sold by the Smith, Beggs and Ranken Machine Company, a corporation duly created and existing by and under the laws of the State of Missouri, at the City of St. Louis, in said State, and that said corporation is alone responsible to the complainant for all the acts, matters and things complained of in said suit; and this defendant denies that said machines, so made by said corporation, are made in violation of any rights of the complainant under and by virtue of said Letters Patent or otherwise" (p. 8).

The patent in suit is entitled "Improvement in frames " for horizontal engines."

A certified duplicate of the Patent Office model is in evidence (p. 19), an inspection of which will be of great assistance in understanding the specification, which appears at page 58 of the record. We will not repeat its language here.

Referring to the model, drawing and specification, it will be seen that the patented engine frame consists of a so-called combination of certain parts which we will now proceed briefly to describe.

The steam cylinder is shown at "A." It forms no part of the thing patented. The subject matter of this controversy consists of a single casting described in the specification and drawing as composed of the following

parts: A cylinder head *a;* a semi-circular piece *d;* a guiding cylinder *b*, having openings *ee* in its side to permit access to be had to the crosshead; a trough "D"; a base "H," and a web *t*. The upper edges of the trough are turned over so as to form strengthening parts in the nature of ribs, marked *q* in the drawing; *f* is an extension of the cylinder head *a*, and *w* is a foot which serves as one of the supports of the frame.

The three claims of the patent consist of alleged combinations of certain of the parts of the entire casting, comprising the engine frame. Their language is as follows (p. 59):

"1. A horizontal steam-engine frame in which a cylinder, *b*, for guiding the cross head, is combined with the cylinder head *a* and semi-circular connecting piece *d*, substantially in the manner described."

"2. The combination, in a horizontal engine frame, of the guiding cylinder *b*, base H, and trough-like connection D."

"3. A horizontal engine frame composed of the cylinder head *a*, guiding cylinder *b*, connecting piece *d*, trough D, base H, and web *t*, all combined substantially in the manner described."

There are four models in evidence:

"Defendants' Exhibit Patent Office Model," already referred to, which correctly represents the thing patented (pp. 19, 46).

"Complainant's Exhibit, Wright Model B," which is an incorrect model introduced by the complainant for the purpose of illustrating the thing patented (p. 46).

"Complainant's Exhibit Model of Infringing Structure C," which is an incorrect model designed to represent the engine-frame at Yuengling's brewery (pp. 19, 20, 34, 35).

"Defendants' Exhibit correct Yuengling Model," which is a true model of those parts of the engine frame at Yuengling's brewery which are incorrectly represented by said model "C" (pp. 19, 20, 34, 35).

The subject matter, if patentable at all, is properly one for a design patent under §4929 R. S., and not for a patent for an "art, machine, manufacture or composition of matter," or an improvement thereof under §4886 R. S. The plaintiff could at the utmost have obtained a monopoly of his design for fourteen years, and the patent would have expired on November 18, 1887.

These cases were argued together before Judge Wheeler on February 3d, 1888, who filed his decision on February 13th, 1888, dismissing the bill in each case, with costs (33 Fed. Rep., 655). The following is his opinion (p. 76):

These suits are brought upon alleged infringements of letters patent No. 144,818, dated November 18, 1873, and granted to the orator for an improvement in frames for horizontal engines.

"The specification describes an engine frame consisting of a cylinder head, connected with a cylindrical cross-head guide, having openings giving access to the cross-head, by a cylindrical piece having a circular opening in its upper side, giving access to the stuffing box of the cylinder head; of a trough-shaped piece connecting the other end of the cross-head guide with a base, and raised on one side over the base to furnish a support for the crank shaft, and curved downward between the sides to make room for the connecting rod, and of a strengthening rib under the cross-head guide and its connections from the base to the cylinder head. There are three claims: The first is for a horizontal engine frame, in which a cylinder for guiding the cross-head is combined with the cylinder head and semi-circular connecting piece, substantially in the manner described. The second is for the combination in a horizontal engine-frame of the guiding cylinder, base, and trough-like connection, and the third is for a horizontal engine-frame composed of the cylinder head, guiding cylinder, connecting piece, trough, base, and web, all combined substantially in the manner described. The question is whether the defendants have taken any part of the orator's invention that is patentable and has been actually patented to him in this patent. A corporation with which the defendant in one case is connected as an officer, has made and sold to the defendant in the other case who has used an engine with a frame consisting of a cylindrical cross-head guide, with openings in its sides, giving access to the cross-head and a stuffing box, bolted to the cylinder head, and of a trough-

like connection between the guide and base, and of a base and a strengthening web like those of the orator's patent. The engine frame has no connecting piece between the cross-head guide and cylinder head separate from the guide, but the cross-head guide is bolted directly to the cylinder head, and the latter does not form any part of what is called the "engine frame" in the patent. Therefore, the combination of the first claim is not to be found in that engine-frame, and that claim is not infringed by it. The trough-like connection between the cross-head guide and base, of the second claim, performs nothing new, nor anything different from other connections in that place; neither does the guide, or the base of that claim, do anything more or different from what other guides and bases in the same relations had previously done; and these parts together do nothing new or anything in any new way, or with any different effect, from what similar parts had for a long time previously done. If anything new is involved in this combination, it consists in the form of the respective parts, or some of them, and such new form is not covered by this patent. Therefore, this claim does not cover any patentable invention, and is not valid. (*Machine Co.* vs. *Murphy*, 97 U. S., 120).

"The third claim covers all the parts of a horizontal engine-frame, including the cylinder-head, as an element in combination. As the engine-frame of the defendants does not take in the cylinder head as a part of it, after the manner of the patent, and has not the connecting piece of the patent between the cross-head guide and cylinder-head, it does not appear to infringe that claim; and, generally, steam engines have had, and must have, rigid frames connecting the working cylinders with the crank shafts to keep them in their proper relative positions, and horizontal engines have had, and must have, bases to sustain the parts. The cross-head guide usually lies in the direction of the frame, and is connected with or forms a part of it. Cylindrical guides were not new with this invention, and those composed of bars for slides were open, affording access to the cross-heads and to the stuffing boxes of the cylinder heads. There would not appear to be any patentable invention in leaving openings for such access in cylindrical guides. The orator added no new part but the connecting piece, which the frame of the defendants does not have. The parts made use of in the frame of the defendants operate precisely in the same manner that similar parts operated before his invention, and accomplish precisely the same result. The form given by him to several of the parts appears to be taken,

but the form was not patented. The patent covers only mechanical operation, and does not appear to be valid to cover anything of that which has been taken. *Estey* vs. *Burdett*, 109 U. S., 633; *Thatcher Heating Co.* vs. *Burtis*, 121 U. S., 286.

"On any view which the case is capable of, the patent does not appear to be valid in any part covering the engine frame of the defendants, if at all. Let there be a decree dismissing the bill of complaint, with costs."

BRIEF OF THE ARGUMENT.

I.—The so-called three combinations, stated as claims in the patent, are nothing but aggregations.

This is so clearly demonstrated by Mr. Brevoort, that we cannot do better than to quote his language (p. 45).

"Q. 8. State how, if at all, these several parts that are stated as elements of the several claims of Wright's patent No. 144,818 co-operate to produce a result?

A. They do not co-operate to produce a result except in the sense that they exist in one casting; each part of the entire structure performs its own function without in any manner modifying the action of any of the other parts, and each part would perform the same function independent of the other parts if it was aggregated with a set of entirely different parts. For example, the guiding cylinder "b" would operate precisely in the same way were it aggregated with a connecting piece that was not semi-circular. In the second claim the base "H" would operate to support the frame in the same way, whether the frame was a trough-like frame or any other form of frame, or whether a guiding cylinder was used, or flat guides were used. The web "t" would operate to strengthen the frame in the same way, whether the frame was one shape or another shape, or whether the cylinder head "a" was cast with it, or whether it was cast separately from it. I might multiply the illustrations by taking up each of the so-called elements of each of the claims separately, but it is unnecessary."

Mr. Renwick, the expert witness for the plaintiff, does not undertake to deny this statement, and it stands uncontradicted upon the record.

We might safely rest the case upon this point alone.

The plaintiff having stated his claims in the form of combinations of elements, admits that the novelty resides alone in the combinations, and that each separate element is material in each combination.

> Water Meter Co. *vs.* Desper, 101 U. S., 332.
> Gage *vs.* Herring, 107 U. S., 640, 648.
> Brown *vs.* Davis, 116 U. S., 249.

"In Hailes *vs.* Van Wormer, 20 Wallace, 353, where "the patentee had taken a fire-pot from one stove, a flue "from another, and a coal reservoir from a third, and had "put them into a new stove, where each fulfilled the office "it had fulfilled in its old situation, and nothing more, "the patent was held void for want of invention" (112 U. S., 249).

This familiar doctrine has been frequently reiterated by this Court.

> See Morris *vs.* McMillin, 112 U. S., 249.
> Thatcher Heating Co. *vs.* Burtis, 121 U. S., 295, and cases cited.

Applying the language of the Court in the case last mentioned to this engine frame, we may say that any "new and improved result in the utility of the *engine* "*frame* cannot be said to be due to anything in the com- "bination of the elements which compose it in any other "sense than that it arises from bringing together old and "well-known separate elements, which when thus brought "together operate separately each in its own old way "(page 294)."

> See also Union Edge Setter Company *vs.* Keith, 139 U. S. 530, 539.
> Hendy *vs.* Miners' Iron Works, 127 U. S., 370, 375.

II.—In view of the state of the art, the thing patented was destitute of patentable novelty.

We cannot do better than to quote the language of Mr. Brevoort upon the subject (pp. 39–43, 44, 45):

Q. 6. Have you examined and do you understand the following Letters Patent of the United States, exhibits in this cause, granted

To Samuel Wright, December 26, 1837, No. 540;
To Gelston Sanford, February 15, 1859, No. 22,981;
To William Wright, August 8, 1865, No. 49,334;
To John B. Root, August 14, 1866, No. 57,190;
To Albert A. Wilson, October 3, 1871, Design Patent, No. 5,305;
To James B. Maxwell and Ezra Cope, February 13, 1872, No. 123,635;
To Chilion M. Farrar, March 19, 1872, No. 124,801:
To Edward H. Cutler, November 26, 1872, No. 133,305;
To George H. Babcock, December 10, 1872, No. 135,741,

and if so, compare what is contained in said several patents with the subject matter of said Wright patent No. 144,818, and also compare said patents with the Yuengling structures?

A. I have read the several patents referred to in the question, and I think I am acquainted with the structures which these patents show and describe. I will take them up in the order of their date and will indicate that which they show which bears upon the alleged invention of Wright.

I will speak first of the Samuel Wright patent of 1837. This patent shows a locomotive, the cross-head of which is guided within a guiding cylinder, which is a true and complete cylinder, as in the case of the Wright patent in controversy and the certified duplicate of the model. In the old locomotive this cylinder is bored true, and the cylinder, besides guiding the cross-head, also serves the purpose of a pump. All that this patent shows in this connection is that a cylindrical guide was old, and by a cylindrical guide I mean a guide which is formed from a complete cylinder, like the guides of the Wright patent in controversy, and not a so-called cylindrical guide, such as is found in the Yuengling structures.

The patent of Gelston Sanford of 1859 shows a vertical

steam-engine in which there is a cylindrical guide, cast solid with a steam-cylinder, and the patent says as follows:

"I bore out the elongated part on a line corresponding to the sides of the cylinder, which gives a true line for the cross-head 'E' to work in." * * *

I will quote from another part of the patent:

"I make all the connections in the ordinary way. The great advantages of this mode of construction are in the use of a cylindrical form of the cross-head 'E' working in a cylinder, making the whole more simple and cheaper and less liable to get out of order." * * *

This patent, like the last one, shows that it was old to attain true alignment of the steam cylinder and cross-head guide by boring with the same bar. Of course, in this patent there is a connecting piece between that portion of the frame in which the cross-head works and the cylinder, and if the Wright patent is broadly, for any connecting part or portion, however shaped, then there is such a connecting portion in the Sanford patent.* I might remark before I leave this patent that the draughtsman has made an error in the location of the steam piston or of the crank. The piston ought to be at the top of the stroke if the crank is not altered, or, if the piston is not altered, the crank should be at the bottom of the stroke.

I will next refer to the patent of William Wright, taken out in the year 1865. This patent shows a horizontal engine bolted to a boiler. The frame is constructed as follows, and I quote from the specification of the patent:

"That the head of the cylinder 'a' is cast in one piece with the bed plate or frame 'F,' which is a shell of a semi-cylindrical form, so as to partially inclose the moving parts of the engine."

Thus this frame has the cylinder head "a" of the Wright patent in controversy. It has a semi-circular connecting piece which is exactly like the semi-circular connecting piece "d" of the Wright patent in controversy, and this connecting piece gives access to the stuffing box of the steam cylinder, and at one end merges into the cylinder head and at the other end into that part or portion of the frame which constitutes the guides.† It is true

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* Mr. Renwick (p. 50) meets this by saying, in substance, that the connecting piece has no aperture in it to get at the stuffing box. There are two replies to this: (1). It was not necessary to show such an aperture to one skilled in the art. (2). To make a hole would not involve invention. . He adds a criticism upon the Sanford engine "as described and represented" (pp. 50–51), which is fully met by Brevoort (p. 46).

† This is substantially admitted by Renwick (p. 51).

that in the Wright Patent of 1865 the guides are not trued up with a boring bar, but are trued up in some other way. Now, this patent shows, when taken in connection with the two previous patents, that it was well known to any mechanic how the guiding surfaces could be trued up either by a boring bar, by a planer, or any other well known and desired fashion. Consequently, in the Wright patent of 1865, though guides are shown which are not trued up by a boring bar, any mechanic knew, or rather would have known in the year 1865, that such guides could have been trued up by a boring bar, if such had been desired in constructing the engine, as well as by a planer, or by hand work, and consequently, although the Wright patent of 1865 shows guides which are differently trued up from the Wright patent in controversy, the two kinds of guides were well known substitutes for each other, and an engine containing one form is not substantially different from an engine containing the other form, beyond the mere fact of the employment of different old methods to accomplish the same result. As a matter of fact, to-day, I do not think it would be wrong to state that over 90 per cent. of the engines now in motion have guides trued up as would have been the guides of the Wright, 1865, patent, and not guides trued up by a boring bar as in the Wright patent in suit, or the old patents of 1837 and 1859, which I have referred to. Consequently the semi-circular connecting piece of the Wright, 1865, patent, although it does not merge into a cylindrical guide, merges into its then well known mechanical substitute. Beyond the guiding portion of the frame of the Wright, 1865, patent, the said frame is formed into a cylindrical, trough-like shape and terminates in an enlargement for the shaft-bearing. The old 1865 Wright engine, therefore, has the cylinder head, the semi-circular connecting piece, guides which were well known mechanical substitutes of the guides of the Wright patent in suit, and a trough-like termination of the frame extending to the pillow block.

The Root patent of 1866 also shows a cylindrical guide which can be trued up with the same bar as can the cylinder, the patent stating that it is bored out and is concentric with the cylinder. This patent does not need further comment, merely showing that cylindrical guides were a very old and well-known device.

I will refer next to the patent of Albert A. Wilson, being design patent No. 5,305 for the year 1871. The drawing of this patent shows an upright engine frame. The patent does not state how the guides are trued up, but from the class of engine to which it belongs, I should

judge that the guides were trued up by a boring bar in the then well-known way. This patent shows a double trough-like connection between the guides and the base, and a semi-circular connecting piece which connects the guiding portion of the frame with the upper part thereof. Whether this semi-circular connecting portion merges into the cylinder head, as in the case of the Wright patent, or terminates merely in a flange to which the cylinder is bolted, as in the case of the Yuengling structures, I cannot tell from the patent. But however this may be, if the Yuengling structures have the semi-circular connecting portion "d," then the Wilson frame has it also.*

The next patent to which I shall refer is that granted to James R. Maxwell and Ezra Cope in the year 1872. This patent shows a back-acting engine; that is, two connecting rods extend backward and past the cylinder and make connection with the cranks at the rear of the cylinder. The patent says as follows in regard to the cross-head guides:

"The cross-head is turned off to conform to the guide-ways, which are fitted for the cross head by boring at one setting to bore the steam cylinder."

Thus it is clear that the guides which are here shown as upper and lower slides or fitting strips are bored out truly with the steam cylinder. It does not appear how the cylinder head is inserted; whether it is cast as a part of the frame, or as a part of the cylinder, but whichever way it is cast, there are connecting pieces connecting the guides with the cylinder, which are the equivalents of the part "d" of the Wright patent, if that part is understood as covering any and all forms of connecting portions between the guiding portion of the frame within which the cross-head works and the cylinder or the cylinder head. The frame of the engine is carried back of the cylinder and there terminates in the bearings for the shaft, and in a base or pedestal. The frame toward the end assumes a trough-like form. This Maxwell and Cope engine shows a cylinder, the equivalent of the connecting piece "d," if such piece can be said to include the part in the Yuengling structures that is said to be its equivalent. The Maxwell and Cope engine also shows guides for the cross-head trued out at one setting with the cylinder by a boring bar, the said guides being clearly the equivalent of the guiding cylinder of the Wright patent, if such part of the Wright patent can be said to cover the guiding arrangements of the

* This is substantially stated by Renwick (pp. 51–52).

Yuengling engines.* The Maxwell and Cope engine also shows a trough-like connection, and a rib running along the entire frame.

The next patent to which I will refer is that of Farrar, dated March 19, 1872. This patent shows a frame for a horizontal steam engine, having at one end the cylinder head cast with the frame, a connecting piece, connecting this cylinder head with the guiding portion, a trough-like frame, running from the guiding portion to a base or pedestal, and having the appropriate bearings for the shaft; and also the frame has a rib, which is in substance the rib "t" of the Wright patent, running from one end of the frame to the other. This patent of Farrar has all of the features of the three claims of the Wright patent in suit, with the exception of one difference, if it may be so called, and that is this: Instead of having guides trued up by a boring bar in the old and well-known way, it has flat guides which are known as a mechanical substitute (and have been known ever since the first days of steam engineering) for a cylindrical guide, or a guide trued up with a boring bar. I have known of the existence of guides like Farrar's for over twenty years. In my judgment, there is no invention in substituting for the flat guides of Farrar the guides of S. Wright and of Sanford, in which event the Wright structure and the Farrar structure would be substantially identical. It is true there is a difference in shape in the frame, but this, as I have before said, is not a suit on a design patent for shape or configuration, but is a suit for an engine frame cast in one piece and having certain portions or parts so called. It is true that Farrar's frame is adapted for a double crank, while Wright's frame is adapted for a single crank, but I do not find that this is referred to as an especial feature of the invention, and, indeed, I suppose that if the frame of the Wright engine was provided with a bearing on the other side of the trough, it would be no less the Wright frame, for it is not a question involving novelty to cut away one side of the Farrar frame if a single crank is to be used.

The patent of Cutler of 1872 shows the well-known method of making guides above and below the cross-head in V-shape, the guides being planed up and then set true with the cylinder. This patent is introduced as an excel-

* Mr. Renwick fails to meet these statements (p. 52). His suggestions, based upon the fact that one end of the cylinder is closed because the pillow block is at the opposite side of the steam cylinder from that of Wright, are frivolous. Any mechanic could open an aperture for the connecting rod, if the pillow block were so placed as to require it.

lent example of the old-fashioned V-shape guide, with some improvements in its supports.

The G. H. Babcock patent of December 10, 1872, shows a vertical engine, having a cylinder mounted at the upper part of the frame. The frame is provided with connecting pieces, connecting the cylinder or cylinder-head with the guiding portion, which is practically part of a cylinder (if Yuengling's structures can be said to obtain a cylinder) having fitting-strips apparently bored out, to guide the cross-head, and two trough-like connections running to the base of the frame.

It is unnecessary to go into the consideration of the first and third claims, though all the features referred to in them are shown by the earlier patents (p. 43).

* * * * * *

Q. 7. State whether, in view of the state of the art, it required invention to bring together the several elements that form the alleged combinations of the claims of the Plaintiff's Patent No. 144,818, and give your reasons for any statement you may make?

A. Referring to the first claim, the first feature of the frame there stated is the guiding cylinder "b." This is old in S. Wright and Sanford. The next feature is the cylinder-head "a" and the semi-circular connecting piece "d" in one casting. These two elements are both found in the Farrar structure. Going to the second claim, the guiding cylinder "b" is found in the patents I have above stated. The trough-like connection is found in the Farrar patent, and so is the base "H"; and in this connection I might call attention to the fact that the Farrar bed-plate is supported at its end and its centre by bases, and so is the Wright, and Farrar also has a support at the cylinder end of the frame, which Wright has not.

Turning to the third claim, the cylinder head cast with the frame is shown in the patent of Farrar. The guiding cylinder is shown in Sanford and S. Wright. The same circular connecting piece is shown in Farrar, where it is cast with the cylinder head. A trough-like frame is also shown in Farrar, with a base and with a web at the bottom of the trough.

Not considering the exact shape of the Wright structure, all the elements are old mechanically, and to select from the art the old features and put them together in one casting, merely required judgment and taste to make a sightly frame, but to do this did not require any invention from a mechanical standpoint any more than it would require invention from the same standpoint to bring together old

colors and patterns in a carpet. Such a union, to be pleasing to the eye, would require taste and judgment, but not invention. So also in the matter of strength. Farrar had already made an arch-like or trough-shaped frame which was sufficiently strong; in fact, it would be stronger than the Wright frame, and he had strengthened this frame with a strengthening rib, running its entire length, as in the Wright structure, and with this frame he had combined the cylinder head "a," just as Wright has claimed in the first and third claims. Now, to add to this structure the S. Wright or Sanford guide as the substitute for the flat slides, as the Wright of the present controversy has, or to substitute the Maxwell and Cope guides, as has been done by the builders of the Yuengling structures, merely required a selection from the art of the most available, or rather the desired features* (I cannot say the best, as it is not the general practice to use bored-out cross-head guides in steam engines), (pp. 44, 45).

The Supreme Court of the United States has recently laid down very strict rules as to what constitutes invention. We cannot see how it is possible to sustain the patent in the case at bar, in view of the doctrine laid down in the following decisions:

Vinton *vs.* Hamilton, 104 U. S., 485.
Hall *vs.* Macneale, 107 U. S., 90.
Atlantic Works *vs.* Brady, 107 U. S., 192, 200.
Slawson *vs.* Grand Street Railroad Co., 107 U. S., 649.
King *vs.* Gallun, 109 U. S., 99.
Double-Pointed Tack Co. *vs.* Two Rivers Manufacturing Co., 109 U. S., 117.
Estey *vs.* Burdett, 109 U. S., 633.
Bussey *vs.* Excelsior Manufacturing Co., 110 U. S., 131.

* Mr. Renwick attempts to meet this proposition, but he fails to do so (p. 57). In respect to the substitution of the S. Wright or Sanford guide, he can only venture to say that "it would require contrivance and invention, *perhaps of a very small kind*, to originate the idea that *such a pump as that of S. Wright*" could be made part of the frame. Mr. Brevoort's statement in respect to the Maxwell and Cope guides being brought into defendant's frame is prudently ignored by Mr. Renwick (p. 57).

Pennsylvania Railroad Co. *vs.* Locomotive Truck Co., 110 U. S., 490.
Phillips *vs.* Detroit, 111 U. S., 604.
Morris *vs.* McMillin, 112 U. S., 244.
Hollister *vs.* Benedict Manufacturing Co., 113 U. S., 59.
Thompson *vs.* Boisselier, 114 U. S., 1, 11.
Stephenson *vs.* Brooklyn Railway Co., 114 U. S., 149.
Yale Lock Manufacturing Co. *vs.* Greenleaf, 117 U. S., 554.
Gardner *vs.* Herz, 118 U. S., 180.
Pomace Holder Co. *vs.* Ferguson, 119 U. S., 335.
Thatcher Heating Co. *vs.* Burtis, 121 U. S., 286.
Burt *vs.* Evory, 133 U. S., 349, 358.

III.—The defendant's engine frame does not infringe the plaintiff's patent.

An inspection of the claims will show that it will be convenient to consider the first and third claims in the first place and afterwards to consider the second claim of the patent.

Upon this subject Mr. Brevoort testifies as follows (pp. 35–39, 43, 44):

Q. 5. Compare the subject matter of the first and third claims of Wright's Patent, No. 144,818, with the structures in Yuengling's brewery, heretofore spoken of, and that which is designed to be represented by the model "Complanant's Exhibit Model of Infringing Structure C," corrected by "Defendant's Exhibit Correct Yuengling Model."

A. The patent of Wright to which I am referred, describes an improvement in frames for horizontal engines. I may say at the outset that it does not appear that any distinction

is to be drawn between a horizontal engine, an inclined engine, and a vertical engine. In all cases, the frames must be of sufficient strength to bear the necessary strain, and as the Wright patent is not for a design, but for a mechanical structure, mere questions of shape are not, as I understand it, to be considered. If the frame of the Wright engine was bolted to a vertical wall, it would still be the same structure as it is when laid upon a horizontal floor and bolted thereto. I do not know that this question is one of importance in this case, but I call attention to the fact so that there may be no misunderstanding as to my meaning. The Wright patent describes an engine frame consisting of the following parts, as specified in the said patent: Beginning at the steam cylinder, the frame is first to consist (and by the frame I mean the single casting that composes it) of a cylinder head, marked "a"; a semi-circular connecting piece marked "d;" a guiding cylinder marked "b;" a trough-like connection marked "D"; a base, "H," and a web, "t." The patent says:

"The extreme rear end of the frame, and forming part of the same, is the head 'a' of the steam cylinder 'A.' * * * A semi-circular connecting piece 'd' merges at one end in the guiding cylinder 'b,' and at the other end in the cylinder head 'a,' thus uniting the two. * * * This combination in a horizontal engine frame of a guiding cylinder 'b,' cylinder head 'a' and connection 'd,' constitutes an especial feature of my invention."

Further on in the patent I find it stated that the ribs "q" "terminate at an extension of the cylinder head 'a.'" From the above quotations it will be evident that the cylinder head "a" is to form an integral part of the casting which constitutes the frame and is to be a homogeneous part thereof, the specification stating, as I have above quoted, that this constitutes, in connection with other parts, an especial feature of the Wright invention.

I will next refer to the semi-circular connecting piece "d." The patent says of this part of the frame as follows:

"A semi-circular connecting piece 'd' merges at one end in the guiding cylinder 'b' and at the other end in the cylinder head 'a,' thus uniting the two. The open top of the said connecting piece permitting ready access to be had to the stuffing box of the cylinder head.

"This combination in a horizontal engine frame of a guiding cylinder 'b,' cylinder head 'a' and connections 'd' constitutes an especial feature of my invention."

From this quotation it is clear what the semi-circular connecting piece is to be. It is to be a piece which connects

the steam cylinder head cast as part of the frame, with the guides, or guiding cylinder as called and illustrated in the patent; and the connecting piece is distinguished from the guiding cylinder in that it is to be only semi-circular, and permit ready access to be had to the stuffing box. It is, in fact, to admit of access to the stuffiing box with perfect freedom throughout a complete half-circle; such access being had, not through a mere hole or opening, but through the maximum-sized opening that can be obtained by cutting away one-half of the frame at this portion, and the combination of this semi-circular piece "d," integral at one end with the cylinder head, and at the other end with the guiding cylinder, is an especial feature of the Wright invention.

I will now consider the guiding cylinder "b." This is described all through the Wright patent as a guiding cylinder, and in no other way. It is stated in the specification that the guiding cylinder has lateral openings in it, so as to permit of access being had to the cross-head; but from the specification, the drawing, and the certified model, the guiding cylinder is described and shown as a mere cylinder, bored out throughout its entire internal surface. The cross-head was to fit this cylinder and be guided therein, the cylinder itself constituting the guide. Beyond the guiding cylinder is a trough-like connection, the base and the pillow block. I need not describe these parts in detail. Thus the frame of an engine is composed of a cylinder-head, a semi-circular connecting piece, a guiding cylinder, a trough-like connection and a base; these being names given to different portions of the same casting, the entire casting constituting one part or thing in itself, and being thus divided up by name for the ease of description which such division of the parts gave to the solicitor who drew the patent, the metal itself being homogeneous from end to end of the single thing constituting the frame, which in this structure also includes the cylinder-head as part and parcel thereof.

I will now consider the first and third claims, and will state what I understand to be the combinations therein pointed out, and I will then compare the said so-called combinations with the machinery that I saw at Yuengling's, which is also represented by the correct model and the model "C" in the manner before stated.

The first claim is for a combination, the combination being made up by the attempt to combine various portions of the structure, which structure, as I have before stated, is in itself a unit or single structure. The portions of this

single piece of metal which are referred to in the first claim are:

(1.) A cylinder "b," which is the guiding cylinder.

(2.) The cylinder head "a," which is the head of the steam cylinder, and

(3.) The semi-circular connecting piece "d."

These are the three portions which are referred to in the specification as constituting the special feature of the Wright invention.

Turning now to the two models, to wit: "Defendant's Exhibit, Correct Yuengling Model," and "Complainant's Exhibit, Model of Infringing Structure C," I will compare them, and also the Yuengling structures, with the portions of the engine frame which are recited in the said first claim. The first portion referred to is the guiding cylinder "b." As I have before said, in the patent and in the certified duplicate of the model of Wright, this part is shown as a cylinder having its entire interior surface bored out, so that it might guide a cross-head in the same way that a piston is guided in a cylinder. In Yuengling's structure and in the two models this is not the case. The guiding surfaces in Yuengling's structure and in the two models are an upper and a lower guide, formed of two slides or fitting strips, the surfaces of which are bored out, but no other portion of the alleged cylindrical guide in these structures is bored out. Thus the Yuengling structures have not got a guiding cylinder bored out throughout its interior, but they have merely two guides, or fitting strips, one above and one below, which are bored out, and the shape of the rest of the portion of the frame which sustains the fitting strips is immaterial. It might be cylindrical, or it might be square, or any other shape. Thus, really, the Yuengling structures have not got the guiding cylinder, which is described and illustrated in the Wright patent.

The next portion of the frame which is referred to in the first claim is the cylinder head "a." In the Yuengling structures and in the models which illustrate them, there is no cylinder-head forming a part of, cast with, and constituting a homogeneous portion of the frame. The cylinder-head in the Yuengling structures is a part of the cylinder and not part of the frame—the frame of the Yuengling structures terminating in a flange adapted to be bolted to a cylinder-head, and in no sense does this constitute a cylinder-head. Consequently the Yuengling structures do not contain one of the important and essential portions of the frame referred to in the first claim, to wit, a cylinder-head "a," and neither have the Yuengling

structures any equivalent for the cylinder-head forming a portion of the frame.

The other portion of the frame referred to in the claim is the semi-circular connecting piece "d." As I have before said, this portion is to be in the shape of a semi-circle, leaving an opening a full half of the guiding cylinder for access to the stuffing box. In the Yuengling structures the entire side of that part of the frame through which the cross-head operates is open, not half-way around, but part way around, and this opening is oval in shape and narrower at each end than in the centre, and thus the alleged equivalent for the semi-circular connecting piece must be found, if found at all, in that continuation of that part of the frame through which the cross-head operates which extends between the position of the cross-head in its rearward movement and the cylinder. This part is not a semi-circular portion, and neither is it open to the extent of the guiding portion of the so-called cylinder itself. In the model "C" a swell is shown, bounded by a rib at the small end of the swell, between the steam cylinder and the portion of the guides where the cross-head plays, but still even in this model there is no semi-circular portion, but there is a part that constitutes almost an entire circle, the opening thus made not "permitting ready access to be had to the stuffing box of the cylinder head," but on the other hand rendering the access most difficult, as I have myself observed.*

It does not seem to me, as I understand the portions of the frame referred to in the first claim, that the Yuengling structures have any of the parts referred to in the claim as those parts are defined by the specification. It is true that the Yuengling structures have guides, and that they have a portion connecting the guides with the end of the frame, but there is no semi-circular connecting piece, either as such, or as a piece which at one end merges into the guiding cylinder and at the other end into the cylinder head. This latter, to wit, the merging of the semi-circular connecting piece into the cylinder head cannot well take place, and, as a matter of fact, does not take place in the Yuengling structures, where no cylinder head exists as a part of the frame.

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* It appears that Mr. Brevoort had carefully examined the machinery itself (pp. 34, 35). Mr. Renwick disagrees with Mr. Brevoort on this subject, but he does not appear to have looked at the structures themselves (p. 56), but he expressly refers to the models This is important, as the subject is the *actual size* of a hole, and no scale is given for the models. It appears also that the plaintiff's expert and brother had free access to the machinery (p. 9). Mr. Renwick could have examined it.

Turning to the third claim, I find that the same portions of the frame are there referred to, but that the trough "D," the base "H" and web "t" are added portions of the frame—added to that which sets out to form the alleged combination of the said third claim.

It is unnecessary to repeat the reasons before given why the parts referred to in the third claim are not found in the Yuengling structures. In the Yuengling structures there is no cylinder head "a," nor is there any equivalent for it. There is no guiding cylinder, but only two trued-up fitting strips within a portion of the frame which bears some resemblance to a cylinder, and in the Yuengling structures there is no semi-circular connecting piece "d," but there is a mere continuation of that part of the frame through which the cross-head operates. The opening in the said guiding portion, instead of increasing so as to form a semi-circular connecting piece as in the patent, decreases, so as to prevent, if anything, ready access to the stuffing box of the steam cylinder, and in this way preventing, instead of permitting, ready access to be had to the stuffing box of the steam cylinder, which is to be an especial feature of the semi-circular connecting piece of the patent. The semi-circular connecting piece permits of ready access to the stuffing box in a way that the comparatively small opening in the Yuengling structures cannot. Therefore, I am clearly of the opinion, that the Yuengling structures have not got the alleged combination of the first and third claims, because they have not:

1. Any cylinder head or equivalent therefor.
2. Because they have not got a semi-circular connecting piece, and as I understand the patent, it is limited to a connecting piece made in the form of a semi-circle.
3. Because they have not got a guiding cylinder as such, but merely an upper and lower guide, one at the top and the other at the bottom, cast into that which in the Yuengling structures has been wrongfully called a guiding cylinder.

It is true that the surfaces of the fitting strips in the Yuengling structures are trued up by a bar such as might be used for boring a complete cylinder, and in fact are so trued-up, but it is equally true that in the Yuengling structures the boring bar used does not as a matter of fact true up the internal surface of a cylinder, but only the surface of two fitting strips, one above and the other below the centre line of the cross-head (p. 39).

* * * * * * *

As to the second claim, the Yuengling structures do not contain the combinations of the said claim, for, as I understand the patent, the cylindrical cross-head guide is to be one which is bored out throughout its entire interior, as would be a steam cylinder. The patent says:

"* * * And the portion of the frame which in ordinary engines is devoted to the usual flat slides consists of a hollow cylinder "b," arranged concentrically with the steam cylinder and serving as a guide for the cross-head, the guiding cylinder being simply bored out to receive a cross-head adapted to it in a manner which need not here be explained."

Further on in the patent I find the following language:

"The cylinder 'b' not only forms the main body of this portion of the frame, but serves at the same time as a cross-head guide, which can be readily prepared for service by the same bar which is used for boring out the cylinder."

From these quotations it would seem that the guiding cylinder referred to by Wright was to resemble that of the 1837 S. Wright patent, or the 1859 Sanford patent, in which the interior surface of cylinders themselves are used as guides, and such a construction is clearly shown in the certified duplicate model, as well as in the drawing of Wright's patent, No. 144,818. What Wright seems to have done in the patent in suit was to combine the S. Wright or the Sanford cylindrical guides with the frame of Farrar, substituting one well-known form of guide for another equally well-known form of guide. It is true that there is a change of shape when the Wright patent in suit is compared with the Farrar patent, but such change in shape is not a matter of invention,* but is a matter depending merely upon the designer's wishes and having relation rather to the beauty of the structure produced than to any mechanical effect which he desired to produce. One form might be lighter and more graceful than another form, but so long as sufficient strength was present, the mechanical effect of one form and another form, so far as the shape of the trough-like portion goes, is the same, and consequently, as I regard the matter, first of all, the Yuengling structures have not got the so-called combination of parts referred to in the second claim; and, secondly, the so-called combination is not one which required any invention to produce,

* Mr. Renwick meets this very guardedly. He *does not say positively* that this change of shape *is* a matter of invention (pp. 56–58).

in view of the state of the art as shown in this case; for to substitute one well-known form of guide for another does not constitute invention, but is a mere matter of mechanical judgment. Both Wright and Sanford used a guiding cylinder, and Sanford cast the guiding cylinder as a part of the frame of the engine. The Yuengling structures, on the other hand, do not have a cylindrical guide in the sense of the Wright patent, but the guides of the Yuengling structures are like those of the Maxwell and Cope patent. The Maxwell and Cope structure is cut out to a greater extent on the sides than are the Yuengling structures, thus giving a somewhat easier access to the cross-head, but this is immaterial.

I might call attention to this fact, which seems of importance when comparing these structures: The specification of the Wright patent says that the guide " * * * consists of a hollow cylinder 'b,' arranged concentrically with the steam cylinder." As the device is shown and described, the entire interior surface of the guiding cylinder is by the boring tool made concentric with the cylinder; whereas in the Yuengling structures the cross-head moves back and forth upon two fitting strips precisely like those of the Maxwell and Cope patent, and these are the only parts of the structure in which the cross-head operates that are necessarily concentric with the cylinder. The other portions might be square, or any shape, or, in fact, they might be cylindrical and eccentric in relation to the steam cylinder.

In respect to the non-infringement of the second claim, Mr. Brevoort further states as follows (pp. 46, 47):

Q. 11. The specification of the plaintiff's patent, No. 144,818, states as follows:

"The cylinder 'b' not only forms the main body of this portion of the frame, but serves at the same time as a cross-head guide, which can be readily prepared for service by the same bar which is used for boring out the cylinder."

Compare the Yuengling structures with what is described in the patent in the respects just mentioned.

A. As to the boring out with the same bar, I have already considered this point and need not state anything further in regard to it. As to the cylinder "b," forming the main body of this portion of the frame, it very clearly does so in the plaintiff's structure, as will be more plainly seen by an examination of the drawing and model. In the Yuengling structures, on the other hand, what has been

called the equivalent of the cylinder by plaintiff's witness, Wright, is *cut away on one side so as to lose its strength as a cylinder*, and the strength of the frame at this portion has been made up by a *large and heavy foot or base*, which extends almost the *entire length* of the part said to be the equivalent of the guiding cylinder of Wright. In this way the strength of the frame at the guiding portion lies rather in the foot or base than in the portion above it, and it cannot be correctly said that the part containing the guiding surfaces "forms the main body of this portion of the frame." These considerations further confirm my view that the Yuengling structures do not contain the so-called combination of the second claim of the plaintiff's patent.

The guiding cylinder *b* is given great prominence in the specification, and it forms an element in each of the so-called combinations of the three claims. The specification states, among the objects of the invention, "to dispense "with much of the fitting and other costly work demanded "by the ordinary frames of engines of this class," and it "states that "the portion of the frame which, in ordinary "engines, is devoted to the usual flat slides, consists of a "hollow cylinder, *b*, arranged concentrically with the "steam cylinder, and serving as a guide for the cross-head, "the guiding cylinder being simply bored out to receive a "cross-head, adapted to it in a manner which need not "here be explained," etc. It is further stated that "the "cylinder *b*, not only forms the main body of this portion "of the frame, but serves at the same time as a cross-head "guide, which can be readily *prepared for service by the "same bar which is used for boring out the cylinder*."

Mr. Renwick, in his deposition, states as follows (pp. 48, 49):

"The third part of the frame is what the patent calls the guiding cylinder *b*, the axial line of which is the same as that of the steam cylinder; the trough is attached to the front part of this cylinder, and it is stated that this cylinder serves as a cross-head guide, '*which can be readily prepared for service by the same bar which is used for boring out the cylinder*,' thus doing away with costly fittings, etc."

He also says (p. 49):

The only use that I can see in casting the guiding piece *b* as a cylinder, instead of a trough, is to provide the necessary upper bearing for the cross-head, and in such location that it *can be bored out and trued by the same bar by which the steam cylinder is bored out.*"

Again, in distinguishing the S. Wright patent of 1837 from the patent in suit, he says, in reference to the cross-head guide and its relation to the steam cylinder, "but 'they would not be *bored out after the two were in place*" (p. 50.)

Mr. Renwick again says:

"The cylinder, whether fully or partly bored out, not "only forms, in the words of the patent, the main body "of this portion, but serves at the same time as a cross-"head guide, which can be readily *prepared for service* "*by the same bar which is used for boring out the cylin-*"der" (p. 56.)

Thus it will be seen that the boring out of the guiding cylinder by the same bar which bores out the steam cylinder, so as to insure an absolutely true alignment, is, upon the face of the patent and in the opinion of plaintiff's expert, an especial feature of the invention. Mr. Brevoort also alludes to this feature (see pp. 40, 42, 43, 44, 46).

The stress laid upon this feature by plaintiff's expert seems to be with a view to support the patentability of the present subject matter by trying to bring it within that class of patents where a process is used for the purpose of creating a product, and the process is said to inhere in the product, a good example of which will be found in Goodyear Dental Vulcanite Co. *vs.* Smith, 1 Banning & Arden, 201; affirmed 3 Otto, 486. Mr. Brevoort, however, clearly demonstrates that this same process is described in several of the older patents as used for the same purpose.

Now, as a matter of fact, the defendants use no such process. It is proved, without contradiction, by Anthony W. Smith, one of the officers of the company that manufactured the machines in question, that the machines were made as follows (p. 18):

"In constructing such engines we proceed as follows: The frame without the cylinder is cast, and where the cross-head is to bear, fitting strips are provided at the top and bottom of the frame adjacent to the cylinder. A boring-bar is then adjusted upon centres, and the said fitting strips are bored, thus forming the guides, and at the same operation the end of the frame is faced up, so as to bring the end of the frame at right angles with the guides. While this is being done, the cylinder is bored by a boring-bar in another machine, the operation of which consists in boring the cylinder and facing its flanges. An annular projecting ring is left upon the front of the cylinder, which enters the end of the frame, so that the cylinder may be brought central with the guides. Meanwhile the cylinder-head and stuffing box are turned up in another machine. The parts are then put together, and in some cases they will be found to be in perfect alignment, and in other cases, with the same exercise of care, the spring of the tools will leave the work not quite true, and to obtain exact alignment, the front of the cylinder or the end of the frame will have to be scraped for the purpose of obtaining the necessary truth of cylinders and guides. In no case do we bore out the cylinders when bolted to the frame. The engine and compresser at Yuengling's brewery, which are the subject of the above entitled suit against Yuengling, were made and fitted in the manner above described."

It may be here remarked that there is no special utility in the mode of boring out the guiding cylinder described in the plaintiff's patent. Although this method of fitting the guide into true alignment with the steam-cylinder is very old, manufacturers usually prefer to adopt other methods (pp. 41, 45).

IV.—The suit against Yuengling should be dismissed for want of equitable jurisdiction.

The facts upon this subject are clearly set up in the answer as follows (p. 6):

"X. That the alleged improvements claimed by the plaintiff to be secured by said Letters Patent affect but a

small part or modification of entire machines; that the defendant is not a manufacturer of the horizontal engines complained of as embodying the alleged invention of the complainant's said Letters Patent, nor is he a dealer in the same; that he is engaged in business in the city of New York as a brewer, and that the engine complained of is used in his brewery for the actuating of a refrigerating machine used in the defendant's said business; that the said horizontal engine was purchased by the defendant in entire good faith, and with no intent or design to violate any rights of the complainant under said Letters Patent, and with no knowledge of such violation, and that the defendant in no manner competes in business with the complainant; that, by reason of the premises, it would be improper to grant an injunction in this cause; that the defendant would suffer greater injury by reason of the injunction being granted than the plaintiff would suffer by reason of the injunction being withheld; and that no remedy peculiar to a Court of Equity or appropriate thereto should be awarded herein; that the plaintiff has a full, adequate and complete remedy at law; and this Court, sitting as a Court of Equity, has no jurisdiction to entertain this suit."

These allegations are fully supported by the proofs (pp. 25–27, 17).

The case of *Smith* vs. *Sands*, 24 Fed. Rep., 470, is directly in point. Adopting the language of the Court in that case (p. 472), we may say, "Since *Root* vs. *Railway* "*Co.*, 105 U. S., 189, was decided, in which Mr. Justice "Matthews reviews the patent laws and the decisions "under them, showing when the remedy is in equity, and "when the sole remedy is in a Court of law for the in-"fringement of Letters Patent, no Court of equity, it is "believed, would assume jurisdiction in a case like "this."

Long prior to the case of *Root* vs. *Railway Co.*, Mr. Justice Nelson and Judge Shipman, sitting in the District of Connecticut (1864), in *Lowell Manufacturing Co.* vs. *Hartford Carpet Co.*, 2 Fisher, 472, dismissed a bill on final hearing, saying, "If there be infringement, injunction "would not be the appropriate remedy under the circum-"stances stated" (p. 476).

See also Hoe *vs.* Boston Daily Advertiser Co., 14 F. R., 914, and cases cited in opinion.

We submit that these cases conclusively show that the bill against Yuengling should be dismissed, without reference to any questions affecting the validity of the patent or its infringement.

V.—In the suit against Johnston Beggs, a decree for injunction only could, in any event, have been awarded in the Court below.

The patent in suit having expired on November 18, 1890, there is no question upon appeal that this Court will consider.

There is no proof of infringement on the part of Johnston Beggs, except as an officer of a corporation, and while an injunction might perhaps have issued against him before the patent expired, there could be no decree for profits or damages except against the corporation.

To quote the language of Elastic Fabrics Co. *vs.* Smith, 100, U. S. 110, 111, "*The appeal, therefore, presents only "a moot case, except as to costs.*"

This defense is substantially set up in the answer (paragraph X, p. 8).

The facts in regard to this matter appear very fully in the deposition of Johnston Beggs (p. 27, etc.).

He is the president of the Smith, Beggs & Ranken Machine Company, a corporation duly organized under the laws of the State of Missouri. An exemplified copy of the certificate of incorporation is in evidence (p. 28).

The company was originally incorporated in 1874, under the name of "The Smith, Beggs & Co. Machine Works," and the present name was adopted in 1879, as will more fully appear by the certificate (p. 28).

The corporation began the manufacture of the steam

engine containing the frames in controversy in 1876, and they gave it the name of the Centennial engine (p. 28).

The plaintiff filed his bill against "Anthony W. Smith, "Johnston Beggs and John D. Ranken, doing business "under the firm name and style of *Smith, Beggs & Ran-* "*ken Machine Company*, at the city of St. Louis, in the "State of Missouri."

It thus appears on the face of the bill that the plaintiff knew that this concern in St. Louis called itself *a company*, and he ought naturally to have inferred that it was a corporation (p. 8).

That the plaintiff's theory of estoppel is wholly untenable is too plain to merit argument. It is all completely swept away on the re-direct examination (pp. 32, 33).

R-D. Q. 97. Referring to the engine frames which are the subject of these suits, *who actually built and sold them*, the corporation of which you are and have been an officer, that you have spoken of, the certificate of which is in evidence, or a copartnership firm known as Smith, Beggs & Co., assuming such firm to have been in existence when such structures were built?

A. The corporation.

R-D. Q. 98. Who got the money on the sale of such structures?

A. The corporation.

* * * * * * *

R-D. Q. 100. Have any of the machines which are the subject of this controversy ever been *used* by a copartnership firm of Smith, Beggs & Co., assuming such copartnership to have existed during the period of the existence of such machine?

A. No, sir.

We understand it to be the settled practice not to grant a decree for an accounting or assessment of damages against an officer of a corporation under circumstances such as these, and that while the officers are frequently joined as defendants in a suit against a corporation, the object is merely to obtain an injunction or discovery against the natural persons sued.

The case of The United Nickel Company *vs.* Worthington, 13 Fed. Rep., 392, Lowell, *C. J.*, 1883, is directly in